

REMARKS

Claims 13-37 are now pending in this application.

Original claims 1-12 were canceled.

Response to Election of Species Requirement

Within the Election of Species Requirement the Examiner specifically indicated that the methods for preparing a peritoneal dialysate at reduced carbonyl content included the following species:

- i. an absorbent cartridge that traps carbonyl compounds with a carbonyl compound-trapping agent; or
- ii. a carbonyl compound-trapping agent that is not used in conjunction with an absorbent cartridge; and
- iii. the carbonyl compound-trapping agent is a patentably distinct species, for example a species selected from one of groups (1)-(31), set forth on page 8, line 20 to page 10, line 15 of the specification.

Applicants elect the species (i) designated by the Examiner with traverse. Specifically, applicants elect the Examiner's designated species "an absorbent cartridge that traps carbonyl compounds with a carbonyl compound-trapping agent" which election is made with traverse.

In response to the original Restriction Requirement applicants elected Group III drawn to methods of preparing a peritoneal dialysate having reduced carbonyl content by using a carbonyl compound-trapping agent. That election encompassed original claims 8 and 9. Further, as pointed out within the response to the Restriction Requirement the original claims were cancelled and new claims 21 and 22 as well as new claims 27-37 are directed to the elected method. It is applicants position that claims 21, 22 and 27-37 are also directed to the elected species.

Independent claims 20, 21, 27 and 29 all require that the peritoneal dialysate be placed in contact with the carbonyl compound-trapping agent. When this occurs the carbonyl compound-trapping agent reduces the level of carbonyl compounds in the peritoneal dialysate. Thus, all of the independent claims 20, 21, 27 and 29 share a special technical feature which is not believed to be disclosed within the prior art.

Applicants claimed invention includes reducing the highly reactive carbonyl compounds

within the peritoneal dialysate thereby eliminating the problem of carbonyl stress. The Baxter reference cited within the Office Action is not directed to such a problem. More specifically, Baxter appears to be directed towards providing a stable two-part dialysate that operates at a neutral pH buffered between 7.0 and 7.6. In accordance with the system disclosed by Baxter the bicarbonate ions act as pH buffers and not as carbonyl compound-trapping agents. Accordingly, the bicarbonate ions of the Baxter system do not reduce the carbonyl stress.

Applicants have attached a copy of U.S. Patent 5,827,820 issued October 27, 1998 which appears to be the U.S. counterpart of the PCT publication cited within the Office Action.

With respect to claim 20 Baxter does not disclose "passing a peritoneal dialysate through and absorbent cartridge that traps carbonyl compounds within the peritoneal dialysate.

With respect to independent claim 21 Baxter does not disclose "contacting the peritoneal dialysate with a carbonate compound-trapping agent; and

(b) separating the peritoneal dialysate from the carbonyl compound-trapping agent."

With respect to independent claim 27 Baxter does not disclose "passing a peritoneal dialysate through an absorbent cartridge comprised of a carbonyl compound-trapping agent;

and allowing the carbonyl compound to be trapped by the agent thereby reducing the carbonyl compounds in the peritoneal dialysate."

With respect to independent claim 29 Baxter does not disclose passing the peritoneal dialysate through and absorbent cartridge;

allowing the peritoneal dialysate to remain in contact with the absorbent cartridge for a period of time and under conditions so as to allow carbonyl compounds present in the peritoneal dialysate to bind to the absorbent cartridge;

recovering peritoneal dialysate having a reduced carbonyl compound content as compared with the peritoneal dialysate entering the absorbent cartridge.

Accordingly, each of the independent claims 20, 21, 27 and 29 are believed to be patentable over the prior art including Baxter and are believed to share a "special technical feature" which distinguishes them from the prior art thereby allowing these claims to be examined within a single group. Applicants recognize that the elected group is the group designated by the Examiner as "an absorbent cartridge that attracts carbonyl compounds with a carbonyl compound-trapping agent. It is recognized that not each of the elected independent claims specifically require the presence of the absorbent cartridge. However, the claims do require the step of contacting the peritoneal dialysate with at least one carbonyl compound

trapping agent wherein the carbonyl compound-trapping agent reduces the level of carbonyl compounds in the peritoneal dialysate. This shared step comprises the “special technical feature” that distinguishes the present invention from the prior art. Thus, all of the independent claims share all of the same or corresponding “special technical features,” unity of invention exists among the claims and any attempts to subdivide the claims of the invention into different species should not take place. Specifically, applicants believe that the allowability of any one of the independent claims such as claims 20, 27 and 29 which do require the absorbent cartridge requires examination of the other independent claims and a finding of allowability of these claims.

Applicants have made a diligent effort to completely and fairly respond to the election of species requirement put forth in the Office Action of June 11, 2003. If for any reason the Examiner believes that further communication is necessary on this matter the Examiner is respectfully requested to contact the undersigned attorney at the indicated telephone number to arrange for an interview to expedite disposition of this application.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-0815, order number SHIM-008.

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

Date:

11/August/03

By:

Karl Bozicevic
Registration No. 28,807

BOZICEVIC, FIELD & FRANCIS LLP
200 Middlefield Road, Suite 200
Menlo Park, CA 94025
Telephone: (650) 327-3400
Direct: (650) 833-7735
Facsimile: (650) 327-3231

Attachment: U.S. Patent No. 5,827,820

F:\DOCUMENTS\SHIM (Shimizu, formerly SHI)\008\resp restr reqmnt 2.rtf